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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/740,930	12/21/2000	Lawrence M. Ausubel	21736/0011	7304

7590 10/21/2004

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EXAMINER

POINVIL, FRANTZY

ART UNIT	PAPER NUMBER
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3628

DATE MAILED: 10/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/740,930

Applicant(s)

AUSUBEL ET AL.

Examiner

Frantzy Poinvil

Art Unit

3628

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 23 July 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-21 and 27-50 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-21 and 27-50 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Claim Objections*

1. Applicant is advised that should claims 27-32 be found allowable, claims 33-38 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

### **Response to Arguments:**

2. Applicant's representative argues that Fujisaki does not describe a "decision means" has the function of "determining whether an auction should continue or terminate". In response, the Examiner disagrees with applicant's assertion. Whether or not such a teaching is noted in Fujisaki, the Examiner notes that most auctions will eventually stop or terminate based on the occurrence of a certain event. Moreover, Fujisaki clearly teaches this well-known and well-applied procedure found in most auction systems. Applicant is directed to column 7, lines 24-27, 53-51; column 10, lines 32-59; column 13, lines 21-27 of Fujisaki. As in most auctions systems, winning bids or objects are usually assigned to a winner. It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the teachings of Fujisaki into the Fisher et al system in order to determine when to end the auction so as to determine a winner of a particular object.

Applicant's representative then argues that the Walker patent has nothing to do with an auction and therefore Walker should not be combined with Fisher and Fujisaki.

In response, Fujisaki has been applied to note teachings of awarding or assigning a complementary object to a successful purchaser of a first object. Furthermore, it is noted that Fujisaki does award winning objects to a winner of an auction. The type of awards attributed to a winning object is not a basis for patentable subject matter. In any event, one of ordinary skill in the art seeking to assign a complementary object to a winner of an auction system would have turned to Walker for this teaching. Applicant is directed to the teachings of Walker et al. at column 13, lines 50-65 and column 7, lines 55-67.

Applicant is reminded that the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teachings of Walker et al into the combination of Fisher et al and Fujisaki in order to assign a complementary second object to a successful bidder of first objects based on the bids for the first objects. The motivation would have been to increase the sale of the second objects and or to increase customer's loyalty to the auction system.

Other arguments are incorporated in the rejection below.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3, 5-6 and 9-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fisher et al (US Patent No. 5,835,896) in view of Fujisaki (US Patent No. 4,789,928) and Walker et al (US Patent No. 6,415,262).

As per claims 1, 9 and 10, Fisher et al discuss a computer implemented auction system comprising an auctioneer system coupling to at least two remote user systems. The user system is a general purpose computer comprising means for receiving messages from the auctioneer's system and for displaying messages; means for receiving bid related information from users; means for transmitting bid information to the auctioneer's system. See the entire document.

The auctioneer's system including means for generating and transmitting messages to user system, means for receiving bid information from user systems. See the entire document.

Repeating the steps of inputting bids and determining at the computer based on the bids whether the auction should continue is not explicitly stated in the Fisher et al system. Fujisaki discloses an auction information transmission processing system. The system comprises a host terminal and a plurality of dealer terminals that submit bids to the host terminal. Note the abstract and figure 1 of Fujisaki. Fujisaki further discloses a decision means responsive to the bid information received from the user systems for determining whether an auction should continue or terminate, the decision means including means to initiate the generation of a non-final

message to at least one user system in response to a determination to continue an auction. Note column 7, lines 24-27 and 53-51; column 10, lines 32-59; column 13, lines 21-27 of Fujisaki.

As in most auctions systems, winning bids or objects are assigned to a winner. It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the teachings of Fujisaki into the Fisher et al system in order to determine when to end the auction so as to determine a winner of a particular object.

The combination of Fisher et al and Fujisaki does not explicitly teach assigning a complementary second object to a successful bidder for a first object based on the bids for the first objects. Systems for awarding or assigning a complementary second object to a successful purchaser of a first object and based on purchased conditions of the first objects are well known in the art. Applicant is directed to the teachings of Walker et al. at column 13, lines 50-65 and column 7, lines 55-67.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teachings of Walker et al into the combination of Fisher et al and Fujisaki in order to assign a complementary second object to a successful bidder of first objects based on the bids for the first objects. The motivation would have been to increase the sale of the second objects and or to increase customer's loyalty to the auction system.

As per claim 2, Walker et al teach assigning the second objects contemporaneous to the step of assigning the first objects. See figures 15B and 16 of Walker et al. The motivation for so doing would have been to automatically provide such an offer to the winner because one object is usually used or work with a second object.

As per claim 3, Walker et al teach the prices for second objects are based on the prices of first objects as reflected in the successful bids. See column 8, lines 21-35, column 9, lines 24-28, column 12, lines 50-67 and column 14, lines 35-45.

As per claim 5, see the teachings of Fujisaki discussing terminating an auction in the event no new bids were submitted and wherein step C) also transmits new bidding information to bidders in the event the auction is terminated.

As per claim 6, one or more bidders may win an object in the combination of Fisher et al, Fujisaki and Walker et al.

As per claims 2, 3, 5 and 6, the motivation to combine is the same as applied to claim 1 above.

4. Claims 4 and 7-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fisher et al. (US Patent No. 5,835,896) in view of Fujisaki (US Patent No. 4,789,928) and Walker et al (US Patent No. 6,415,262) as applied to claim 1 above and in view of and Fritts.

The combined teachings of Fisher et al, Fujisaki and Walker et al are discussed above. As per claim 4, the combined teachings of Fisher et al, Fujisaki and Walker et al do not explicitly state the first objects are spectrum licenses for communication spectrum and second objects are related clearing rights for television transmission in the same or adjacent spectrum. The Examiner asserts that these kinds of data do not affect the functionality of the system of the combination of Fisher et al, Fujisaki and Walker et al as these are merely different types of data that do not change the result of the combined system. These are different intended types of “items”, “things” or “objects” that would have been obvious to the skilled artisan when gleaning

from the combination of Fisher et al, Fujisaki and Walker et al. Applicant is directed also to column 14, lines 43-46 of Fujisaki where it is indicated that the system "can be applied to the auctioning of various articles". Furthermore, granting of a first license that requires another license is well known in the art of communication that one license must work in complement with another license. See the teachings of Brian Fritts at page 13 of the article entitled "Private property, economic efficiency and spectrum policy in the wake of the C block auction". Having complementary objects as taught by Fritts in the combination of Fisher et al, Fujisaki and Walker et al would have been obvious to one of ordinary skill in the art in order to increase the efficiency of auction allocation and to allow an entity to enter a package bid or a group of licenses.

The teachings of Fisher et al, Fujisaki and Walker are discussed above. As per claim 7, Walker et al teach informing the user of first objects and of secondary or complementary objects. Note column 7, lines 55-67 and column 13, lines 50-65. Walker et al also disclose the complementary objects is based on the purchased condition of the first objects. Fritts discloses informing users of complementary auctions and a relation of the first and second objects or licenses. Note page 13 of the reference. Walker et al also disclose selecting a relation between the price of a second object and the price of a second object. See column 14, lines 46-65 and column 12, lines 50-67 of Walker et al. The motivation to combine Fisher et al, Fujisaki, Walker et al and Fritts would have been to increase the efficiency of auction allocation and to allow an entity to enter a package bid or a group of licenses.



As per claim 8, participating bidders in the combination of Fisher et al, Fujisaki, Walker et al and Fritts are bidders who enter bids at least the selected relation or who accede to the selected relation.

5. Claims 11-21 and 33-50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fisher et al. (US Patent No. 5,835,896) in view of Fujisaki (US Patent No. 4,789,928) and Walker et al (US Patent No. 6,415,262) as applied to claim 1 above and in view of and Fritts.

As per claims 11, 18, 33-39, 43 and 47, these claims contain features addressed in claim 1 and these features are likewise rejected in view of Fisher, Fujisaki and Walker. Walker et al disclose presenting complementary objects to a purchaser that is based on constraints of a purchase of a first item or object. Fritts teaches a system and method for providing communications rights to bidders wherein two or more bidders participate in the auction. See the entire document. The licenses include clearing rights. Each of the agreement concerns television broadcasting rights or other encumbrances to one or more licenses for communications spectrum. See especially page 15 of Fritts. Fritts disclose conducting auctions for one license and other associated licenses and two or more bidders participate in the auction system. One license is granted based on another associated license. Note the teachings of Fritts. Fritts also discloses providing complementary objects and ending an auction. Note page 13 of Fritts. The Examiner notes that most licenses are limited to certain related clearing rights. Steps of determining whether an auction should continue is discussed by Fujisaki. A similar scheme is taught by Fritts. Note page 4 of Fritts. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Fisher et al, Fujisaki, Walker

et al and Fritts in order to increase the efficiency of auction allocation and to allow an entity to enter a package bid or a group of licenses.

As per claim 12, note the teachings of Fritts as being directed to granting of clearing rights.

As per claims 13 and 14, the combination of Fisher et al, Fujisaki, Walker et al and Fritts involves performing the functions using a computer.

As per claim 15, applicant is directed to the rejection of claim 7 above. Events causing to terminate an auction are discussed by Fujisaki. Furthermore, Fritts teaches that the winner of the auction has the highest bid related to the clearing rights and communications licenses.

As per claims 16 and 17, the functions in the combination of Fisher et al, Fujisaki, Walker et al and Fritts are performed by a computer or with the aid of a computer.

As per claim 19, the objects of concern in Fritts are communication licenses and clearing rights related to a communication license.

As per claim 20, an auction is usually terminated when no new acceptable bids are received as such would have been obvious in the combination of Fisher et al, Fujisaki, Walker et al and Fritts in order to determine when to end the auction.

As per claim 21, both Fujisaki and Fritts teach an acceptable bid is a bid of a greater price than a preexisting bid.

The combined teachings of Fisher et al, Fujisaki and Walker et al are discussed above. As per claim 44, the combined teachings of Fisher et al, Fujisaki and Walker et al do not explicitly state the first objects are spectrum licenses for communication spectrum and second objects are related clearing rights for television transmission in the same or adjacent spectrum.

The Examiner asserts that these kinds of data do not affect the functionality of the system of the combination of Fisher et al, Fujisaki and Walker et al as these are merely different types of data that do not change the result of the combined system. These are different intended types of “items”, “things” or “objects” that would have been obvious to the skilled artisan when gleaning from the combination of Fisher et al, Fujisaki and Walker et al. Applicant is directed also to column 14, lines 43-46 of Fujisaki where it is indicated that the system “can be applied to the auctioning of various articles”. Furthermore, granting of a first license that require another license is well known in the art of communication that one license must work in complement with another license. See the teachings of Brian Fritts at page 13 of the article entitled “Private property, economic efficiency and spectrum policy in the wake of the C block auction”. Having complementary objects as taught by Fritts in the combination of Fisher et al, Fujisaki and Walker et al would have been obvious to one of ordinary skill in the art in order to increase the efficiency of auction allocation and to allow an entity to enter a package bid or a group of licenses.

As per claims 40, 45 and 48, most auctions usually terminate when no acceptable bids are received. As per claim 49, in most auction systems, a condition is set up that an acceptable bid is a bid of greater price than a preexisting bid. Thus, as per claims, 45, 48 and 49, performing these functions in the combination of Fisher, Fujisaki, Walker and Fritts are merely trivial desired rules settings that would not change the method and system of the combination of Fisher, Fujisaki, Walker and Fritts and thus would have resulted in no patentable differences over the combined references.

As per claims 41 and 46, the combination of Fisher, Fujisaki, Walker and Fritts does not explicitly teach an acceptable bid for a second object is a bid that is at least great in price as a specified multiple of a bid for an associated first object. As per this limitation, the Examiner notes that bidders bid on one object and associated objects. Bidding for an object based on the price of another object is one of a multiple possible bidding or payment scenarios that is based on the type of auction as would be determined by the auctioneer or rules of the auction system as such would not affect the functioning of the combination as Fisher, Fujisaki, Walker and Fritts taken as a whole. Thus, performing this function in the combination of Fisher, Fujisaki, Walker and Fritts are merely trivial desired rules settings that would not change the method and system of the combination of Fisher, Fujisaki, Walker and Fritts and thus would have resulted in no patentable differences over the combined references.

As per claims 42 and 50, bids are usually assigned in force at the time the auction is terminated.

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


### **Conclusion**

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frantzy Poinvil whose telephone number is (703) 305-9779. The examiner can normally be reached on Monday-Thursday.

The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

FP  
October 14, 2004

  
FRANTZY POINVIL  
PRIMARY EXAMINER  
Au 3628